

REMARKS

The Amendment of Claims 1, 15 and 16 merely involves changes in the form of the language used. The substantive addition to Claim 25 involving the casting technique to form optical lenses is supported in the specification, for example, on page 11, line 19 to page 12, line 7.

New Claim 26 reciting a range of 5% by weight to a maximum of less than 20% by weight for the quantity of C in the mixture of B+C, is supported by the range of 5 to 20% on page 5, line 23 of the specification, and the values for such quantity of C of less than 20% by weight in Example 1 and Compositions 2, 3 and 4 on pages 14 to 19, while new Claim 27 reciting a maximum of 13.4% of C is supported by Example 1 on page 15 of the specification.

Claims 1, 15 and 16 have been rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The rejection of Claim 1 is believed to be overcome by the Amendment of the claim to recite that the composition is "polymerizable", which is an art-recognized description, in place of the functional expression "can be polymerized".

The substitution of accepted *Markush* terminology for the objectionable phrase "such as ... and the like" in Claim 15 is believed to overcome the rejection of this claim.

Finally, the functional phrase "capable of generating" in Claim 16 as applied to free radicals has now been replaced by the direct action verb "generate" which is believed to eliminate the basis for the rejection of this claim.

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Claim 25 has been rejected under 35 USC §101 on the ground that it recites a use without any steps involved in the process which is not a proper process claim under the statute. However, this claim has now been amended to directly recite a process for manufacturing optical lenses, including the step of pouring the recited composition into the cavity of a mold and polymerizing it by means of a thermal treatment. The amended claim is therefore clearly not subject to rejection under 35 USC §101 as an improper process claim.

Claims 1-25 have been rejected under 35 USC §102(b) as being "clearly anticipated" by *Renzi et al.* '293. This rejection is respectfully traversed. It should be noted first that there is no single species, i.e., specific composition, of *Renzi et al.* which falls within the weight percent range of polyol (C) in the mixture of aliphatic diol (B) and (C) of 5 to 20% by weight, or the molar ratio of A/B+C of 2.5/1 to 4/1 recited in Applicants' independent Claim 1. The Examiner therefore is apparently relying on the overlapping between Applicants' range of weight percent of C/B+C of 5 to 20% and the broad range of "equal to or lower than 70%" or the narrower range of "20 to 60" disclosed by *Renzi et al.*, and between Applicants' range of molar ratio of A/B+C of 2.5/1 to 4/1 and the broad range of "equal or higher than 3/1" or the narrower range of "3/1 to 12/1" disclosed by *Renzi et al.* It is submitted, however, that this is not sufficient alone as the basis for an anticipation rejection under 35 USC §102. Thus, as pointed out in MPEP 2131.03, 8th Ed., in cases involving overlapping ranges, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute" and "what constitutes 'sufficient specificity' is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with sufficient specificity' to constitute an anticipation of the claims". The foregoing quoted language from the MPEP section is believed to be directly in point with regard to the

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instant rejection. Thus, both the broad range of "equal to or lower than 70%" and the narrow range of "20 to 60%" of *Renzi et al.* applied to the weight percent of C/B+C are both much broader than Applicants' range of "5 to 20%", with the minimum of 20% of the narrower range of 20 to 60% of *Renzi et al.* touching Applicants' maximum of 20% at only a single point. Similarly the broad range of "equal to or higher than 3/1" and the narrower range of "3/1 to 12/1" disclosed by *Renzi et al.* for the molar ratio of A/B+C are both much broader than the range of 2.5/1 to 4/1 claimed by Applicants.

It can also be seen from the results shown in Tables 1, 2 and 3 of the specification that the compositions of the present invention can be used to make organic glasses having perceptibly better properties, e.g., of yellow index, impact strength, abrasion resistance, and dyeability (Y), than the composition of *Renzi et al.*, as well as having lower shrinkage during polymerization. This would not have been predicted from the *Renzi et al.* disclosure by a person having ordinary skill in the art and is therefore an unobvious result which supports a lack of sufficient specificity in the disclosure of *Renzi et al.* necessary for a holding of anticipation under 35 USC §102, as well as that of unobviousness necessary for patentability under 35 USC §103.

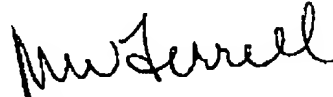
It may also be of interest that while clearly not binding on this proceeding, the European Patent Office as International Preliminary Examining Authority, held in the International Preliminary Examination Report of the corresponding PCT application, that claims similar to those presently in issue in this application had novelty and inventive step with regard to the disclosure of *Renzi et al.* '293 as prior art, for reasons similar to those expressed previously in support of the argument against anticipation.

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This application is now believed to be in condition for allowance, and such action at an early date is earnestly solicited.

Respectfully submitted,



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